REMARKS

The above Amendments and these Remarks are submitted under 35 U.S.C. § 132 and 37 C.F.R. § 1.111 in response to the Office Action mailed January 22, 2009.

Summary of the Examiner's Action and Applicants' Response

The Examiner objected to the Specification. Claims 17, 18, 19-25, 33-34, and 51-52 were rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. The Examiner rejected Claims 1-5, 9-13, 17-22, 26-29, 33-39, 43-47, and 51-52 under 35 U.S.C. § 103(a) as being obvious based on Landsman, et al. (U.S. Patent No. 6,317,761, "Landsman") in further view of Wen (U.S. Pat. Pub. 2001/0047297). Claims 6-8, 14-16, 23-25, 30-32, 40-42, and 48-50 were rejected under 35 U.S.C. § 103(a) as being obvious based on Landsman in view of Galomb (U.S. Pat. App. Pub. 2001/0039510) and further in view of Wen. Applicants respectfully traverse the rejections.

In this Amendment, Applicants have amended Claims 1, 2, 5-10, 13-20, 22-27, 29-36, 39-44, and 47-52. Claims 3, 4, 11, 12, 21, 28,37, 38, 45, and 46 have been canceled No new matter has been added.

After entry of this amendment, Claims 1, 2, 5-10, 13-20, 22-27, 29-36, 39-44, and 47-52 will be pending.

Response to Objection to the Specification

The Examiner objected to the Specification as failing to provide proper antecedent basis for "memory" and "computer readable storage medium" in the claims. The Examiner stated that "it is necessary to use this terminology in order to properly define the claim within the boundaries of statutory subject matter. In order to overcome the object[ion], an amendment to the Specification is necessary constituting a non-exhaustive statement of what the phrases 'memory' and 'computer readable storage medium' would be as it would have been known to one of ordinary skill in the art at the time of the invention, in order to verify that the terms 'memory' and 'computer readable storage medium' could not be taken in the context of non-statutory subject matter".

Applicants respectfully submit that the term "memory" is explicitly disclosed in the original claims, i.e., in Claims 9, 26, and 43. The claims as filed in the original specification are part of the disclosure which form part of the original specification, per MPEP § 2163.06. Applicants have

amended the Specification on page 9 to explicitly include this disclosure of the "memory" in the original claims to provide more explicit specification support for memory and, in turn, for computer readable storage medium.

Moreover, the specification does not contain any express statement or other indication in the record that the term "computer readable storage medium" or "memory" is intended to include non-statutory matter such as signals or paper. The term "computer readable storage medium" and "memory" are thus limited to *only tangible manufactures.* (*Ex parte Mazzara,* Appeal 2008-4741 (BPAI 2009)); therefore, Applicants respectfully submit that the terms 'memory' and 'computer readable storage medium' could not be taken in the context of non-statutory subject matter".

For all of the above reasons, it is respectfully request that the objection to the Specification be withdrawn.

Response to Rejection of Claims 17, 18, 19-25, 33-34, and 51-52 under 35 U.S.C. § 101

Claims 17, 18, 19-25, 33-34, and 51-52 were rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. The Examiner stated that "[t]he claims appear to be claiming 'software systems' i.e., systems without hardware indication, which is a computer program per se. Since the claims disclose computer program per se that is not embodied on a computer readable medium, they appear non-statutory".

Applicants have herein amended Claim 18 to add "based on at least one creative definition stored in at least one computer readable storage medium".

In his response to Applicants' prior arguments, the Examiner tied this § 101 rejection to his perceived lack of specification support for computer readable medium or memory, which has been remarked on above. Applicants respectfully submit that the specification does not contain any express statement or other indication in the record that the term "computer readable storage medium" or "memory" is intended to include non-statutory matter such as signals or paper. The term "computer readable storage medium" and "memory" are *thus limited to only tangible manufactures*; and therefore, Claim 17, 18, 19-25, 33-34, and 51-52 are **directed to statutory matter**. (See *Ex parte Mazzara,* Appeal 2008-4741 (BPAI 2009)).

For all of the above reasons, Applicants respectfully submit, therefore, that Claims 17, 18, 19-25, 33-34, and 51-52 are directed to statutory subject matter.

In addition, when functional descriptive material is recorded on some computer-readable

medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized." (MPEP § 2106.01). For this additional reason, Applicants respectfully submit, that the term "computer readable medium" is sufficiently disclosed and that Claims 17, 18, 19-25, 33-34, and 51-52 are directed to statutory subject matter.

Response to Rejection of Claims 1-5, 9-13, 17-22, 26-29, 33-39, 43-47, 51, and 52 under 35 U.S.C. § 103(a)

Claims 1-5, 9-13, 17-22, 26-29, 33-39, 43-47, and 51-52 were rejected under 35 U.S.C. § 103(a) as being obvious based on Landsman in further view of Wen.

The Examiner acknowledged that Landsman fails to disclose performing the limitations on the server-side system. The Examiner added that:

"On the other hand, Landsman discloses a client/server architecture in a networked environment (Col 15, lines 48-51) wherein the server can be a separate software application which executes on any computer in the networked environment. (Column 15, lines 61-64) Therefore, It was well-known to one of ordinary skilled in the art at the time of Applicant's invention that the functionality of a client/server architecture is applicable and interchangeable between a client and a server since there is no real significant differences between the processing abilities of a client and a server. In addition, one of ordinary skill in the art would not see any reason why certain data processing techniques, once taught, cannot or should not be applied to either the client or server side of a system. Each side contains a data processing unit and techniques for one processing unit may very well be applicable to other data processing units; therefore, a program tailored to be executed on a client can also be executed on a server.
It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modified Landsman's method to perform on a server since it would have provided the benefit of taking advantage of server capabilities of management and distribution duties with other clients that a server provides to a client".

Thus, Applicants respectfully submit that the Examiner stated that Landsman does not teach or suggest executing on the server-side system, if the creative definition is a programmable creative, the programmable creative definition to generate the creative; however, the Examiner stated that it would be obvious to interchange client and server. Further, the Examiner stated that Landsman fails to specifically disclose transmitting the creative through the electronic network from the publisher on a server-side system to the viewer on the client-side system. The Examiner stated that, Wen, however, discloses an advertisement that was created on the server-side being transmitted to the user on the client side. (Abstract, Paragraph 0011, 0045, 80); and it "would have been obvious to one of

ordinary skill in the art at the time of Applicant's invention to have modified Landsman's method with Wen's method. Applicants respectfully disagree that Claims 1-5, 9-13, 17-22, 26-29, 33-39, 43-47, and 51-52 are obvious based on Landsman in further view of Wen.

Applicants have amended Claim 1 to further clarify the claim and further define the invention. Among other things, Claim 1 has been amended to emphasize that the creative is generated within an advertising system, i.e., integrated with, and operated response to the advertising system. Claim 1 has also been amended to emphasize that the server-side system includes the advertising system and a web server, the creative within the advertising system responsive to the advertising system and is stored on the server-side system. Thus, the creative is executed outside of the web server, responsive to the advertising system, rather than being just responsive to a particular viewer request sent from the client-side. Claim 1 has also been amended to emphasize that, a stored creative is selected for transmission as a function of scheduling of the advertising system and a request from the client-side system. The selected stored creative is then transmit through the electronic network from the publisher on the sever-side system via the web server to the viewer on the client-side system, as claimed in Claim 1. Thus, Claim 1 makes more clear the integration with the advertising system, the generation of the creative within the advertising system on the server-side, apart from the web server; the web server being for transmission of the creative that had been generated within the advertising system.

Regarding an "advertising system", the Examiner stated

> "As per dependent claim 2, Landsman et al discloses wherein the step of executing the programmable creative definition to generate the creative includes the step of periodically executing the programmable creative definition responsive to a request generated by an <u>advertising system</u>. (Col 17, lines 7-21, Column 18, lines 38-49: Discloses the <u>advertising system</u> generating a request to download the advertisement based on the <u>URL</u> provided, wherein an applet is then executed to download the advertisement)" (Emphasis added).

At Col. 17, lines 7-21, referenced by the Examiner, Landsman recites:

> "<u>Third-party ad</u> HTTP server 20, connected to Internet 10 via, e.g., communications links 18 and 23, <u>hosts ad management system</u> 25. In essence and as discussed in detail below, this <u>system</u>, in response to a request originating from the AdController agent executing in browser 7, <u>selects a given advertisement and then downloads</u>, in a "polite" manner controlled by the agent, media and player <u>files that form that advertisement to the agent for storage in the browser disk cache</u>. Inasmuch as Java applets are currently restricted under constraints inherent in the Java programming language itself to retrieving files from an identical Internet host that served the applet

itself, <u>the request for an advertisement to system 25</u> as well as resulting media and player files served by system 25 are routed through agent server 15 as a proxy server". (Emphasis added).

At Column 18, lines 38-49 referenced by the Examiner, Landsman recites:

"Another portion of the advertising tag ('AdServer='http://AdManagement.sub.-system') references a <u>URL of a particular ad management system</u> (where 'AdManagement.sub.- system' represents a web address (URL) of that particular system), here illustratively system 25, from which the agent is to download an advertisement. As will be seen below, the Transition Sensor applet, during its execution, passes this URL, as part of an advertising download request, to the remainder of the AdController agent to subsequently <u>download appropriate advertising files</u>, also as described below, <u>from that system</u> necessary to interstitially play an advertisement". (Emphasis added).

Applicants respectfully submit that the above teachings in Landsman are regarding an advertising system 25 hosted by a third-party HTTP server 20, having a "request for an advertisement" sent to the <u>third-party hosted advertising system</u> 25", the <u>advertising system selecting an ad in response to a request originating from the AdController agent executing in browser 7</u> (the browser 7<u> in the client PC</u>, see FIG. 1B), and downloading the ad files from the advertising system 25. Thus, among other things, Applicants respectfully submit that Landsman teaches an advertising system that is third-party hosted and selects an ad responsive to a request from an agent executing in a browser that resides in the client PC, i.e., responsive to a request originating from the client PC, not responsive to the advertising system. In contrast, among other things, in the method as claimed in Claim 1, includes **executing on the advertising system the programmable creative definition** to generate the creative on the server-side system if the creative definition is a programmable creative definition, and that this <u>**executing is responsive to the advertising system**</u>. Furthermore, the method in Claim 1 includes **storing** the (generated) creative on the server-side system. Applicants respectfully submit that, among other things, Landsman and Wen, either singly or in any theoretical combination, do not teach or suggest the responsiveness to the advertising system, the executing on the advertising system of the programmable creative definition, in combination with the storing of the generated creative on the server-side system, as claimed in Claim 1. Applicants respectfully submit that Claim 1 clearly emphasizes the uniqueness of the execution on an advertising processor on the server-side within an advertising system that is not taught or suggested by Landsman and Wen, either singly or in any theoretical combination.

Further, Claim 1 has been amended to further emphasize the integration within the

advertising system and advantages of executing the creative within the advertising system on the server-side by including retrieving, responsive to the programmable creative definition, proprietary data from the server-side system and including at least a portion of the proprietary data in the programmable creative" – further clarifying and incorporating elements formerly in Claims 3 and 4. Regarding Claim 4 in the Office Action, the Examiner stated "As per dependent claim 4, Landsman et al discloses wherein the data is proprietary data. (Column 21, lines 46-60: Discloses data being streamed proprietary, thus the data being proprietary data)" (Emphasis added). Applicants respectfully submit that Column 21, lines 46-60 in Landsman states:

> "The AdDescriptor file implements a data abstraction that totally separates the media and player files from the referring web page, here page 35, thus assuring that the advertisement content itself remains completely independent of the content web page that invoked its presentation. This abstraction permits our technique to provide a highly effective, generalized and very flexible mechanism for delivering rich web advertisements, particularly those that require complex sets of media files and players. Through use of this abstraction, our inventive technique can handle present and future media formats, regardless of their requirements, including proprietary streaming and other content delivery technologies that rely on Java applets as a delivery mechanism--all transparently to the user". (Emphasis added).

Applicants respectfully submit, therefore, that, in contrast to retrieving proprietary data from the server-side system and including at least a portion of the proprietary data in the programmable creative, as claimed in Claim 1, Landsman's teaching in Col. 21, lines 46-60 of "proprietary" is only in regards to proprietary technologies, not proprietary data. That is, it is respectfully submitted that Landsman teaches the use of proprietary technologies for streaming and "content delivery technologies" used for "media formats". Applicants respectfully submit that Landsman does not teach or suggest retrieving, responsive to the programmable creative definition, proprietary data from the server-side system, as claimed in Claim 1. Further, it is respectfully submitted that it follows that Landsman does not teach or suggest "including at least a portion of the proprietary data in the creative", as claimed in Claim 1. Applicants respectfully submit that Wen, singly or in any theoretical combination with Landsman, does not teach the executing on the advertising system, responsive to the advertising system, as claimed in Claim 1.

Further, Applicants respectfully submit that Landsman, singly or in any theoretical combination with Wen, does not teach the selecting of a stored creative by the advertising system for transmission and the transmitting, both as a function of scheduling by the advertising system, as

claimed in Claim 1.

For at least the above reasons, therefore, Applicants respectfully submit that Landsman and Wen, either singly or in any theoretical combination, do not teach or suggest the method as claimed in Claim 1; therefore, Claim 1 is non-obvious based on Landsman in view of Wen.

For all of the above additional reasons, Applicants respectfully submit that Claim 1 is non-obvious based on Landsman in view of Wen. Claims 2 and 5 depend directly or indirectly from Claim 1 and are thus respectively submitted as being non-obvious based on Landsman in view of Wen for the same reasons as given for Claim 1 above.

Claim 9 is generally a system counterpart to Claim 1 and has been amended similarly to Claim 1, and thus it is respectfully submitted as being non-obvious based on Landsman in view of Wen for the same reasons given above for Claim 1. Claims 10 and 13 depend directly or indirectly from Claim 9 and are thus respectively submitted as being non-obvious based on Landsman in view of Wen for the same reasons as given for Claim 9 above.

Claim 17 is generally a system counterpart to Claim 1, and thus is respectfully submitted as being non-obvious based on Landsman in view of Wen for the reasons given above for Claim 1. Claim 18 is generally a program product counterpart to Claim 1, and thus is respectfully submitted as being non-obvious based on Landsman in view of Wen for the reasons given above for Claim 1.

Claim 19 is a method for generating creatives on the server-side system and has been amended to emphasize, among other things, the execution on the advertising system, the executing being responsive to the advertising system, wherein the executing includes retrieving, responsive to the programmable creative definition, proprietary data from the server-side system and including at least a portion of the proprietary data in the programmable creative, as claimed in Claim 19. Applicants respectfully submit that Landsman, singly or in any theoretical combination with Wen, does not teach the executing as claimed in Claim 19. Further, Applicants respectfully submit that Landsman, singly or in any theoretical combination with Wen, does not teach the responsiveness to the advertising system, the selecting and transmitting as a function of scheduling of the advertising system, and the retrieval and inclusion of proprietary data, as claimed in Claim 19. Further, Landsman and Wen, either singly or in any theoretical combination, do not teach or suggest storing the programmable creative on the server-side system; and transmitting the stored creative from the publisher on a server-side system to the viewer on the client-side system, as claimed in Claim 19.

For all of the above reasons, Applicants respectfully submit that Claim 19 is non-obvious

based on Landsman in view of Wen. Claims 20 and 22 depend directly or indirectly from Claim 19 and are thus respectively submitted as being non-obvious based on Landsman in view of Wen for the same reasons as given for Claim 19 above. Claim 26 is generally a system counterpart to Claim 19, and thus is respectfully submitted as being non-obvious based on Landsman in view of Wen for the reasons given above for Claim 19. Claims 27 and 29 depend directly or indirectly from Claim 26 and are thus respectively submitted as being non-obvious based on Landsman in view of Wen for the same reasons as given for Claim 26 above. Claim 33 is generally a system counterpart to Claim 19, and thus is respectfully submitted as being non-obvious based on Landsman in view of Wen for the reasons given above for Claim 19. Claim 34 is generally a program product counterpart to Claim 19, and thus is respectfully submitted as being non-obvious based on Landsman in view of Wen for the reasons given above for Claim 19.

Claim 35 is a method for generating creatives on the server-side system and has been amended to emphasize, among other things, the execution on the advertising system, the executing being responsive to the advertising system, wherein the executing includes retrieving, responsive to the programmable creative definition, proprietary data from the server-side system and including at least a portion of the proprietary data in the programmable creative, as claimed in Claim 35. Applicants respectfully submit that Landsman, singly or in any theoretical combination with Wen, does not teach the executing as claimed in Claim 35. Further, Applicants respectfully submit that Landsman, singly or in any theoretical combination with Wen, does not teach the responsiveness to the advertising system, the selecting and transmitting as a function of scheduling of the advertising system, and the retrieval and inclusion of proprietary data, as claimed in Claim 35. Further, Landsman and Wen, either singly or in any theoretical combination, do not teach or suggest storing the programmable creative on the server-side system; and later transmitting the stored creative from the publisher on a server-side system to the viewer on the client-side system, as claimed in Claim 35. Claims 36 and 39 depend from Claim 36 and thus are respectfully submitted as being non-obvious based on Landsman and Wen for the same reasons given above for Claim 36.

Claim 43 is generally a system counterpart to Claim 35, and thus is respectfully submitted as being non-obvious based on Landsman in view of Wen for the reasons given above for Claim 35. Claims 44 and 47 depend directly or indirectly from Claim 43 and are thus respectively submitted as being non-obvious based on Landsman in view of Wen for the same reasons as given for Claim 43 above. Claim 51 is generally a system counterpart to Claim 35, and thus is respectfully submitted as

being non-obvious based on Landsman in view of Wen for the reasons given above for Claim 35.
Claim 52 is generally a program product counterpart to Claim 35, and thus is respectfully submitted
as being non-obvious based on Landsman in view of Wen for the reasons given above for Claim 35.

Further regarding Claims 2, 10, 36, and 44, these claims include "executing the
programmable creative definition responsive to <u>a request generated by an advertising system</u>". The
Examiner stated that Landsman discloses this step at "(Col 17, lines 7-21, Column 18, lines 38-49:
Discloses <u>the advertising system generating a request to download</u> the advertisement based on the
URL provided, wherein an applet is then executed to download the advertisement)." (Emphasis
added). Applicants respectfully disagree that Landsman teaches an advertising system generating a
request, as claimed in Claims 2, 10, 36, and 44 for at least the following reasons.

Landsman, Col 17, lines 7-21 states:

> "Third-party ad HTTP server 20, connected to Internet 10 via, e.g., communications
> links 18 and 23, hosts ad management system 25. In essence and as discussed in
> detail below, this [ad] system, in response to a **request** originating from the
> AdController agent executing in browser 7, selects a given advertisement and then
> downloads, in a "polite" manner controlled by the agent, media and player files that
> form that advertisement to the agent for storage in the browser disk cache. Inasmuch
> as Java applets are currently restricted under constraints inherent in the Java
> programming language itself to retrieving files from an identical Internet host that
> served the applet itself, the <u>request</u> for an advertisement <u>to</u> system 25 as well as
> resulting media and player files served by system 25 are routed through agent server
> 15 as a proxy server". (Emphasis added).

Thus, Applicants respectfully submit that Landsman, Col 17, lines 7-21, discloses a request
<u>to</u> an ad system 25 (from the Adcontroller agent executing in a client browser), and does not disclose
a responding to a request generated <u>by</u> an advertising system, and therefore does not disclose
"executing the programmable creative definition responsive to a <u>request generated by an advertising
system</u>", as claimed in Claims 2, 10, 36, and 44.

The other portion of Landsman cited in the rejection, Column 18, lines 38-49, reads:

> "Another portion of the advertising tag ("AdServer="http://AdManagement.sub.-
> system") references a URL of a particular ad management system (where
> "AdManagement.sub.- system" represents a web address (URL) of that particular
> system), here illustratively system 25, from which the agent is to download an
> advertisement. As will be seen below, the Transition Sensor applet, during its
> execution, passes this URL, as part of an advertising download request, to the
> remainder of the AdController agent to subsequently download appropriate
> advertising files, also as described below, from that system necessary to interstitially
> play an advertisement". (Emphasis added).

Thus, Applicants respectfully submit that for this portion merely refers to the advertising download request sent to the AdController agent – the AdController agent referenced in Col 17, lines 7-21 above where the <u>request **to** the ad system</u> originates from the AdController agent. Thus, it is respectfully submitted that Landsman discloses a download request is generated by an applet, which passes the URL to the <u>AdController agent executing in browser 7 (on the client side), and is sent to the ad system 7 (on the server side)</u>. For all of the above additional reasons, Applicants respectfully submit that Landsman does not teach or suggest, in either portion referenced by the Examiner or otherwise, "executing the programmable creative definition responsive to a <u>request generated by an advertising system</u>", as claimed in Claims 2, 10, 36, and 44. Further, Applicants respectfully submit that Wen does not teach the request as claimed in these claims. It is respectfully submitted that Landsman and Wen, either singly or in any theoretical combination do not teach or suggest the executing as claimed in Claims 2, 10, 36, and 44. For these additional reasons, Applicants respectfully submit that Claims 2, 10, 36, and 44 are not made obvious by Landsman in view of Wen,.

Response to Rejection of Claims 6-8, 14-16, 23-25, 30-32, 40-42, and 48-50 under 35 U.S.C. 103(a)

The Examiner rejected Claims 6-8, 14-16, 23-25, 30-32, 40-42, and 48-50 under 35 U.S.C. 103(a) as being obvious based on Landsman in view of Galomb and further in view of Wen.

Applicants respectfully submit that the method in Claim 1 is non-obvious based on Landsman in view of Wen for the same reasons as given for Claim 1 above. Further, Applicants respectfully submit that Galomb does not teach or suggest generating a creative within an advertising system on the server-side including, among other things, the executing, as claimed in Claim 1. Applicants respectfully submit, therefore, that Landsman, Wen and Galomb, either singly or in any theoretical combination, do not teach or suggest the method of Claim 1; therefore, Claim 1 is non-obvious based on Landsman in view of Galomb and further in view of Wen. Claims 6-8 depend directly or indirectly from Claim 1 and are thus respectively submitted as being non-obvious based on Landsman in view of Galomb and further in view of Wen for the same reasons given above for Claim 1.

Further, it is respectfully submitted that the mere disclosure in Galomb that an advertisement

may have text and images and disclosing a testing method for such advertisements, does not teach or suggest the step of periodically changing text or images, as claimed in Claim 6. Applicants respectfully submit that Claim 6 is non-obvious based on Landsman in view of Galomb and further in view of Wen for this additional reason.
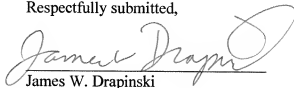
Applicants respectfully submit that Galomb does not teach or suggest the systems of Claims 9, 26, and 43, and the methods of Claims 19 and 35. Applicants respectfully submit that Landsman, Wen and Galomb, either singly or in any theoretical combination, do not teach or suggest the systems of Claims 9 and 26, and the methods of Claims 19 and 35, for the reasons given above for these claims. Claims 14-16, 23-25, 30-32, 40-42, 48-50 respectively depend from Claims 9, 19, 26, 35, and 43 and thus are respectfully submitted as being non-obvious based on Landsman in view of Galomb and further in view of Wen for the same reason given above for the respective independent claims.

Conclusion

For the above reasons, Applicants respectfully submit that all pending claims in the present application are allowable. Such allowance is respectfully solicited.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (415) 984-8200.

Respectfully submitted,

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